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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/066,087

01/30/2002

Benjamin C. Rivera

JPS 756.712

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06/07/2006

CHERNOFF, VILHAUER, MCCLUNG & STENZEL
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EXAMINER

SHAKERI, HADI

ART UNIT

PAPER NUMBER

3723

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/066,087

Applicant(s)

RIVERA, BENJAMIN C.

Examiner

Hai Shari

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61, 69, 73, 77, 79-87 and 99-110 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 79-87 and 101-106 is/are allowed.
- 6) ☒ Claim(s) 61, 69, 73, 74, 77, 99, 100 and 107-110 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
*Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).*
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of Reference Cited (PT O 892)
- 2) ☐ Notice of Disposition of Patent Drawing Review (PT O 948)
- 3) ☐ Information Disclosure Statement(s) (PT O 1449 or PTO/SB/08)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PT O 413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application (PT O 152)
- 6) ☐ Other ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 77, 99, 100, and 107 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 77, the narrative and intended use language as recited, that the flange is free of additional structure forming a second channel, renders the scope of the claims unascertainable, because the frame member for a holding tool, as defined by the original specification, is defined to be joined by another structure, e.g. the scale (36), to define a pocket, otherwise it would not form a "frame member for folding tool". It is noted that "integral" as defined by the specification and its broad definition "formed as a unit with another part", which renders the claims indefinite. Rejection under 112, 1st paragraph for insufficient disclosure is not applied at this time, since it appears that the claim deficiency are of clarity and not of enablement.

With regards to claim 99, the language as recited renders the claims indefinite for making the scope unascertainable, since it appears a method of forming is being claimed in the article claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

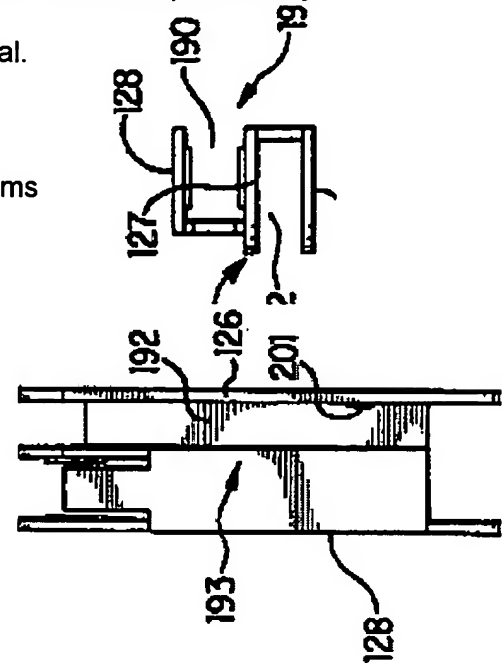
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

Art Unit: 3723

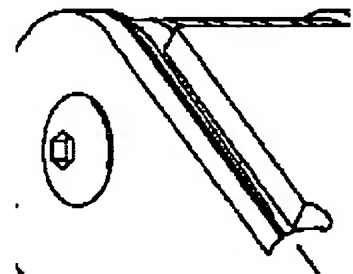
granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 61, 69, 109, 73, 74, 77, 99, 107, 109 and 110 (as best understood) are finally rejected under 35 U.S.C. 102(e) as being anticipated by Taggart et al. (6,341,423).

Taggart et al. discloses all of the limitations of the above claims (as best understood), i.e., a handle for a folding tool comprising an elongate channel-shaped frame member having an outer margin with a first elongate side and first and second spaced-apart elongate channel walls integrally joined together by a channel floor to define a channel (192), said frame member further including an integral first external flange (defining the floor in channel 190) extending outwardly from at least a portion of said first channel wall in a first direction away from said channel, said first external flange including an integral first leaf spring, said first leaf spring forming a portion of said first elongate side of said outer margin.



Regarding claims 99, 107 and 110 Taggart et al. meets the limitation, i.e., wherein the portion of the flange that forms the spring is separated from an adjacent portion of the channel wall by a cut in the channel wall (at the upper edge).



Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3723

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 108, and 100, (as best understood) are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Taggart et al.

Taggart et al. meets all the limitations of claim 108, and 100, except for a second flange extending in an opposite direction. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the tool by including a third channel with wall (128) as the common wall, in adapting the tool to accommodate more tool bit and applications, since it has been held that mere duplication of the essential working parts of a devise involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8., and with regards to another spring, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include an integral spring on the floor defining the channel (192), in adapting the tool for a particular tool bit and application, since it has been held that mere duplication of the essential working parts of a devise involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Allowable Subject Matter

7. Claims 101-103, 79-87, 104-106 are allowed.

8. The following is a statement of reasons for the indication of allowable subject matter: side scale, external flange and side wall defining the pocket as recited places these claims allowable over prior art of record.

Conclusion

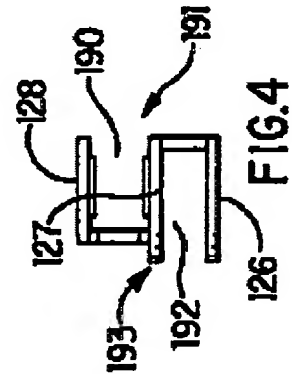
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3723

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Response to Arguments

10. Applicant's arguments filed March 16, 2006 have been fully considered but they are not persuasive. Applicant's arguments that "integral" is not met by Taggart et al. are not persuasive, since a frame member is being recited which is met by even partial sections of the handle as disclosed by Taggart. However the argument with regards to the scale is persuasive, placing the claims that define the pocket in condition for allowance.




Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is (571) 272-4495. The examiner can normally be reached on Monday-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3723

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Hadi Shakeri
Primary Examiner
Art Unit 3723
May 30, 2006